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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,160	01/19/2001	Tetsuo Minakawa	1095.1151/JDH	7615
21171	7590	01/30/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			PHAM, THOMAS K	
		ART UNIT	PAPER NUMBER	2121

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/764,160	MINAKAWA ET AL.
	Examiner Thomas K Pham	Art Unit 2121

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 November 2003.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

***Response to Amendment***

1. This action is in response to request for re-consideration filed on 11/17/2003.
2. New claim 11 has been entered.
3. Claims 1-10 has been considered but they are not persuasive.
4. Claims 1-3, 5-6 and 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by Flake et al. U.S. Patent No. 5,832,451.
5. Claims 8 and 9 stand rejected under 35 U.S.C. 102(b) as being anticipated by Luchs et al. U.S. Patent No. 4,831,526.
6. Claim 4 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Flake et al. U.S. Patent No. 5,832,451 in view of Walker et al. U.S. Patent No. 5,794,207.
7. Claim 7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Flake et al. U.S. Patent No. 5,832,451 in view of Luchs et al. U.S. Patent No. 4,831,526.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 5-6, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Flake et al. U.S. Patent no. 5,832,451 (hereinafter *Flake*).

**Regarding claim 1**

*Flake* teaches

- an intermediation control apparatus that carries out intermediation between a user and a service provider, the intermediation control apparatus comprising: extraction means for determining a range of personal information of a user, for disclosure, based on a kind of request information sent from said user, and extracting said range of personal information from said personal information (col. 19 lines 2-8, "system 10 ... requesting customer.");  
and
- transaction means for making said extracted range of personal information and contents of a request available to said service provider (col. 19 lines 8-15, "the system ... travel request").

**Regarding claim 2**

*Flake* teaches

- an intermediation control apparatus according to claim 1, further including memory means for storing said personal information together with a user ID of said user (col. 7 lines 49-55, "the travel agent ... device 24").

**Regarding claim 3**

*Flake* teaches

- an intermediation control apparatus according to claim 2, wherein said extraction means is responsive to said request information including said user ID (col. 8 lines 58-65, "If the current ... software subroutine 134"),

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- for determining disclosure information of said personal information stored in said storage means based on said user ID and said kind of said request information, and extracting said disclosure information from said personal information (col. 8 lines 33-47, "A customer ... with the queue.").

#### **Regarding claim 5**

*Flake* teaches

- an intermediation control apparatus according to claim 1, further including a management table for managing correlation between said contents of said request and disclosure information of said personal information (col. 3 line 53 to col. 4 line 3, "a relational database ... preferred vendors").

#### **Regarding claim 6**

*Flake* teaches

- an intermediation control apparatus according to claim 5, wherein said extraction means determines said disclosure information based on said management table (col. 4 line 60-67, "The business ... profile information").

#### **Regarding claim 10**

*Flake* teaches

- a computer-readable recording medium which stores an intermediation control program for causing a computer to execute intermediation control, said intermediation control program causing said computer to function as: extraction means for determining a range of personal information of a user, for disclosure, based on a kind of request information

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sent from said user, and extracting said range of personal information from said personal information (col. 19 lines 2-8, "system 10 ... requesting customer."); and

- transaction means for making said extracted range of personal information and contents of a request available to said service provider (col. 19 lines 8-15, "the system ... travel request").

#### **Regarding claim 11**

Flake teaches a method intermediation control between a user and at least one service provider, comprising:

- determining a range of personal information of a user based on a type of request information sent by the user to the at least one service provider (col. 19 lines 2-8, "system 10 ... requesting customer.");
- extracting the range of personal information from said personal information storage (col. 8 lines 53-57, "PNRs are stored by ... a customer has made"); and
- making available the extracted range of personal information and the request available to the at least one service provider (col. 19 lines 8-15, "the system ... travel request").

10. Claims 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by *Luchs* et al. U.S. Patent no. 4,831,526 (hereinafter *Luchs*).

#### **Regarding claim 8**

*Luchs* teaches

- a service providing apparatus connected to a network, comprising: disclosure information-receiving means for receiving disclosure information as a portion of request

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information received from a user, said portion being permitted to be disclosed (col. 6

lines 25-33, "Once the ... policy request."); and

- response information-transmitting means for transmitting commodity information created based on said disclosure information, as response information (col. 15 line 63 to col. 16 line 12, "Once the proper ... calculated at 78.").

#### **Regarding claim 9**

*Luchs* teaches

- A service providing apparatus according to claim 8, wherein said disclosure information-receiving means receives, as said request information sent from said user, disclosure information which is a portion of a request of an estimate of an insurance, said portion being permitted to be disclosed (col. 3 lines 29-38, "Although all ... his insurance.").

#### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Flake* in view of *Walker et al.* U.S. Patent no. 5,794,207 (hereinafter *Walker*).

#### **Regarding claim 4**

*Flake* teaches an intermediation control apparatus according to claim 1, wherein said transaction means makes said extracted range of personal information and said contents of said request

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available to said service provider on a site but *Flake* does not teach service provider is permitted to access the personal information of user through authentication. However, *Walker* teaches service provider is permitted to access the personal information of user through authentication (col. 9 lines 17-22, “a potential seller … by the buyer”). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the authentication of the suppliers of *Walker* with the intermediation travel service of *Flake* because it would provide for uniquely identify the supplier (i.e. airline) and to ensure the capacity to deliver the goods to the buyer before complete the transaction.

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Flake* in view of *Luchs* et al. U.S. Patent no. 4,831,526 (hereinafter *Luchs*).

**Regarding claim 7**

*Flake* teaches an intermediation control apparatus according to claim 1, wherein said extraction means determines said range of personal information of said user, for disclosure, as said request information sent from said user, and extracts said range of personal information from said personal information but does not teach the request is an estimating request of an insurance and a type of said insurance. However *Luchs* teaches the request is an estimating request of insurance and a type of said insurance (col. 16 lines 13-21, “Once the … policy quote 82.”). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the request for insurance of *Luchs* with the intermediation travel service of *Flake* because it would provide for getting the insurance quotation and type in order to buy additional travel insurance or life insurance before starting the trip.

***Response to Arguments***

In the remark the applicant argues that cited reference fails to disclose:

- I) "determining a range of personal information of a user, for disclosure, based on a kind of requested information sent from the user, and extracting range of personal information from said personal information" as to claim 1.
- II) "service provider is permitted to access through authentication" as to claim 4.

In response to applicant's argument,

- I) As stated in claim 1, "a kind of requested information" sent from the user to one of ordinary skill in the art including the name and other information which described personal information of a user. It is noted that prior art (Flake et al. U.S. Patent No. 5,832,451) teaches (column 8 lines 26-28, "a software-driven subroutine 82, which functions to make or change a travel arrangement, in response to a customer's request") and (column 8 lines 29-32, "Essentially, under the control of the process request subroutine 82, system 10 operates to transfer travel and profile information between the relational database in storage device 24 and the agent processing the travel request") and (column 8 lines 49-51, "**Otherwise**, at block 130, the travel agent determines whether or not the current requester can be associated with an existing passenger name record (PNR)"). Therefore, it is clear that the system of Flake determined a range of personal information of a requester based on "a kind of requested information" from a customer's requested information including the customer's name, otherwise, if already the the customer's name and information already exists in the customer database, then, the name can be

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use to retrieve past information in order to process together with the new request as stated in column 8 lines 58-65 of Flake. Thus, limitations are met by the reference.

II) It is noted in prior art (Walker et al. U.S. Patent No. 5,794,207) teaches (column 9 lines 19-22, "The central controller then timestamps the message from the seller and authenticates the identity of the seller and his capacity to deliver the goods sought by the buyer"). Thus, Examiner believes that the seller or service provider must authenticate for permission to access the system as claimed in claim 4. Therefore, the combination of references meets the limitations of the claim.

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***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thomas Pham*; whose telephone number is (703) 305-7587 and fax number is (703) 746-8874. The examiner can normally be reached on Monday-Thursday and every other Friday from 7:30AM- 5:00PM EST or contact Supervisor, *Mr. Anil Khatri*, can be reached on (703) 305-0282.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

**Thomas Pham**  
*Patent Examiner*

January 29, 2004



**ANIL KHATRI**  
SUPERVISORY PATENT EXAMINER